

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte
HANS-JOSEF BUYSCH,
CARSTEN HESSE,
JORG-DIETRICH JENTSCH,
JOHANN RECHNER, and
EBERHARD ZIRNGIEBL

Appeal No. 1999-1459
Application No. 08/625,613

HEARD
FEBRUARY 20, 2002

Before LIEBERMAN, JEFFREY T. SMITH and NAGUMO, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 20 which are all of the claims pending in this application.

THE INVENTION

The invention is directed to a supported heterogenous catalyst and cocatalyst having specified components. In one embodiment, the catalyst is utilized in the preparation of aromatic carbonate compounds. Additional limitations are disclosed in the following illustrative claim.

THE CLAIM

Claim 1 is illustrative of appellants' invention and is reproduced below.

1. A supported catalyst containing, in the reaction-ready state, (i) a platinum metal, a platinum metal halide or a complex containing a platinum metal halide, or a compound which can be converted under the reaction conditions into a platinum metal, a platinum metal halide or a complex containing a platinum metal halide, in an amount of 0.01-15% by weight, calculated as platinum metal and based on the total weight of the catalyst, and (ii) a metal compound acting as cocatalyst from groups IB, IIB, IIIA, IIIB, IVA, IVB, VB, VIB, VIIB, the iron group (atomic numbers 26-28) or the rare earth metals (atomic numbers 58-71) of the Periodic Table of the Elements (Mendeleev) in an amount of 0.01-15% by weight, calculated as metal and based on the total weight of the catalyst.¹

THE REFERENCES OF RECORD

As evidence of anticipation, the examiner relies upon the following reference:

Buyisch et al. (Buyisch)	5,502,232	Mar. 26, 1996
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THE REJECTION

Claims 1 through 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated

¹We note that claim 1 as it appears in the Brief of October 13, 1998, contains two amendments submitted after the Final Rejection and refused entry by the examiner. The amendments are directed respectively to the terms, "on a support" in line 1, and, "said supported catalyst being a heterogeneous catalyst," at the end of the claim. The actual claim before us for consideration is claim 1 as originally filed.

by Buysch.

OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner and agree with the appellants that the rejections of claims 1 through 20 are not well founded. Accordingly, we reverse this rejection.

The Rejections under § 102(e)

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). The examiner relies upon a reference to Buysch to reject the claimed subject matter and establish a prima facie case of anticipation. The premise of the rejection is that the dessicants disclosed by Buysch include activated aluminum oxide, zeolitic aluminum sulfates or Faujasite, which although disclosed as desiccants also function as well known support materials. Furthermore, Buysch does not preclude the use of dessicants as supports. See Answer, page 4. We disagree.

In contrast, appellants' essential argument is directed to the lack of teaching in Buysch of a supported catalyst. See Brief, pages 4-10.

We find that Buysch is directed to a process for the preparation of diaryl carbonates utilizing a catalyst having essentially the same components as required by the claimed

subject matter but for the support. See column 1, lines 5-13, column 2, lines 39 to column 3, line 54. We find that the catalysts of Buysch are in the form of a solution. See Examples 1 through 6. We find no disclosure directed to a supported catalyst. We find that the sole description of a material corresponding to appellants' claimed support lies in Buysch's discussion of "desiccants." We find that the desiccants disclosed by Buysch include materials which overlap the supports utilized by the appellants. We find that examples of such desiccants include aluminum oxide and synthetic aluminosilicates of the zeolite type. See column 5, lines 28-38. These are the same materials disclosed as catalytic supports on page 5, lines 10-26 of the specification. Indeed the appellants state that the supported catalysts can be used as powders. See specification, page 10.

Notwithstanding the above findings, the disclosure of Buysch is directed solely to the use of the aforesaid compounds and others as desiccants in an amount sufficient to remove the water of reaction formed and the moisture of the starting materials. See column 5, lines 39-41. Although the examiner states with respect to the dessicants that, "their use as supports is not precluded by Buysch," Answer, page 5, the issue before us, on the grounds of anticipation, is whether the dessicant as used by Buysch inherently and necessarily functions as a catalytic support as required by the claimed subject matter. In that respect, the examiner has advanced no theory or plausible explanation why the dessicants as used by Buysch would act as a support in the formation of a catalyst as required by the claimed subject matter. Accordingly, no prima facie case of anticipation

has been established.

Based upon the above analysis, we have determined that the examiner's legal conclusion of anticipation is not supported by the facts. "Where the legal conclusion is not supported by [the] facts it cannot stand." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967).

OTHER MATTERS

The examiner should consider whether it would be appropriate to enter an obviousness type double patenting rejection over one or more of claims 1-20 of U. S. Patent No. 6,001,768 which was identified by Appellants as a related case. (Brief at 1).

DECISION

The rejection of claims 1 through 20 under 35 U.S.C. § 102(e) as being anticipated by Buysch is reversed.

The decision of the examiner is reversed.

REVERSED

PAUL LIEBERMAN
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

MARK NAGUMO
Administrative Patent Judge

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